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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/316,795	05/21/1999	RONALD P. SANSONE	E-846	8309

7590 06/04/2002

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EXAMINER

SOUGH, HYUNG SUB

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 06/04/2002

#10

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 10

Application Number: 09/316,795
Filing Date: May 21, 1999
Appellant(s): SANSONE ET AL.

Ronald Reichman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 12, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief contains a statement that there are no other appeals and interferences that relate to the Application.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect. The amendment filed on December 3, 2001, was unsigned and could not be considered as an after final amendment.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that (A) claims 1, 6, 7, 11, and 14, (B) claims 8-10, (C) claims 12-13, (D) claims 15-21, and (E) claim 22 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

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(8) Claims Appealed

A substantially correct copy of appealed claims 1 and 6-22 appears on pages 16-19 of the Appendix to the appellant's brief. The minor errors are as follows: Claim 8, line 1, "1" after claim should read --6--.

(9) Prior Art of Record

5,420,403	ALLUM ET AL	5-1995
5,422,821	ALLEN ET AL	6-1995
6,006,200	BOIES ET AL	12-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 U.S.C. § 103

I. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

II. Claims 1 and 6-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boies et al. (Boies hereinafter: US PAT. 6,006,200) in view of Allum et al. (Allum hereinafter: US PAT. 5,420,403).

Boies discloses a method of forwarding mail (i.e., a package delivered by U.S. Postal Service) that is addressed to a recipient (i.e., "a customer") and a virtual post office box (i.e., "a

unique identifier to the customer”) to be delivered directly to a recipient, said method comprises the steps of:

receiving recipient's name and information regarding recipient's desired delivery address (this step would have been inherent to create the database owned by the shipping company and to generate the unique identifier to the customer);

assigning a virtual post office box for individual recipients (see column 2, line 12, “to supply a unique identifier to the customer”);

relating recipient's virtual post office box with recipient's desired delivery address (this step would have been inherent to be able to deliver the mail to the correct customer);

delivering to recipient's their assigned virtual post office box's identification (see column 2, line 12, “to supply a unique identifier to the customer”);

placing virtual post office boxes on the mail (see column 2, lines 55-60);

reading mail to capture virtual post office box identification, when present (see column 2, lines 60-64);

determining recipient's desired delivery address from virtual post office box information and recipient's name (see column 2, lines 18-22 and 60-64);

verifying in one or more data bases that recipient's name is listed with recipient's desired delivery address (see claim 1, i.e., “accessing the master file database by a shipper to obtain the customer's shipping address.”); and

delivering the mail to the desired delivery address of the recipients (see column 2, lines 60-64).

Re claim 1: Boies does not explicitly disclose the steps of placing recipient's desired delivery address on mail in coded form and human readable form. However, Allum discloses the use of coded form, human readable form or both to print a delivery label (see FIGS. 7 and

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8) to facilitate the routing of the mail automatically and to assist a delivery person to find correct delivery addresses. Thus, it would have been obvious to one of ordinary skill in the art to modify the method of Boies by adopting the teachings of Allum to facilitate the routing of the package automatically and to assist a delivery person to find correct delivery addresses.

Re claim 6: Boies further discloses the step of changing recipient's desired delivery address in accordance with recipient's instructions (see claim 5).

Re claim 7: Boies does not explicitly disclose the changing step that further includes recipient specifies the time period in which mail is going to be delivered to the desired delivery address. However, it is old and well-known practice to specify the time period in which mail is going to be delivered to the changed delivery address (e.g., when someone is on vacation, it has been a common practice to notify the Post Office to reroute the mail to a next neighbor or hold until the person comes back from the vacation), and nothing unobvious is seen to have been involved simply having employed this old and well-known practice for the claimed method to facilitate the mail delivery.

Re claims 8, 9 and 10: Boies does not explicitly disclose the step of billing for the number of times (or metering) recipient's changed their desired delivery address. However, it is a fundamental practice to charge any viable services including the claimed service in the art to obtain higher profit. Thus, it would have been within the level of ordinary skill in the art to employ this fundamental practice to the claimed method to increase the profit.

Re claim 11: Boies further discloses that the recipient's virtual post office box is represented in alphanumeric characters (see column 2, lines 14-16).

Re claims 12 and 13: Boies does not explicitly disclose the steps of (a) assigning access codes to recipients that are related to recipient's virtual post office box; (b) delivering access codes to recipients; (c) receiving recipient's name, access code and recipient's intention to change their delivery address; and (d) changing recipient's delivery address upon conformation

of recipient's name and access code. However, in claim 5 thereof, Boies discloses the step of changing recipient's desired delivery address in accordance with recipient's instructions (see claim 5). Of course, **to keep anonymity and privacy** (see the Abstract of Boies), the use of the claimed steps for changing the delivery address would have been within the level of ordinary skill in the art. More specifically, it would have been obvious to (a) assign access codes (e.g., passwords) to recipients that are related to each recipient's virtual post office box to prevent others from accessing unauthorized post office boxes; (b) deliver access codes to recipients to allow each recipient to access his or her post office box for the desired address change; (c) receive recipient's name, access code and recipient's intention to change their delivery address to update the change of the address; and (d) change recipient's delivery address upon conformation of recipient's name and access code to effect the change of the address.

Re claim 14: Boies does not explicitly disclose the changing step that further includes recipient specifies the time period in which mail is going to be delivered to the changed delivery address. However, it is old and well-known practice to specify the time period in which mail is going to be delivered to the changed delivery address (e.g., when someone is on vacation, it has been a common practice to notify the Post Office to reroute the mail to a next neighbor or hold until the person comes back from the vacation), and nothing unobvious is seen to have been involved simply having employed this old and well-known practice for the claimed method to facilitate the mail delivery.

Re claim 15: Boies does not explicitly disclose the steps of (a) assigning a biometrics to recipients; (b) delivering the biometrics to recipients; (c) receiving recipient's biometrics and recipient's intention to change their delivery address; (d) changing recipient's delivery address upon conformation of recipient's biometrics. However, in claim 5 thereof, Boies discloses the step of changing recipient's desired delivery address in accordance with recipient's instructions

(see claim 5). Of course, to **keep anonymity and privacy** (see the Abstract of Boies), the use of the claimed steps for changing the delivery address would have been within the level of ordinary skill in the art. More specifically, it would have been obvious to (a) assign a biometrics (e.g., finger print) to recipients that are related to each recipient's virtual post office box to prevent others from accessing unauthorized post office boxes; (b) deliver the biometrics to recipients to allow each recipient to access his /her post office box for the desired address change; (c) receive recipient's biometrics and recipient's intention to change their delivery address to update the change of the address; and (d) change recipient's delivery address upon conformation of recipient's biometrics to effect the change of the address.

Re claims 16, 17, 18, 19 and 20: Boies does not explicitly disclose that the recipient's name, access code and recipient's intention to change their delivery address may be received by telephone, by facsimile, by computer, in person, or by mail. However, those are well-known methods of notifying the changes of personal information, and it would have been common sense to employ any one of the above well-known methods as desired to notify the changes of the personal information (e.g., address, phone number, or etc.) to effect the change of the address.

Re claim 21: Boies does not explicitly disclose that the recipient's access code is encrypted. However, it is a well-known practice in the art to encrypt any vital information in the art to prevent fraudulent access of the personal account or database and it would have been common sense to employ this well-known practice for the claimed method to further enhance the **anonymity and privacy** (see the Abstract of Boies) of the recipient.

III. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boies in view of Allum as applied to claim 1 above, and further in view of Allen et al. (Allen hereinafter: US PAT. 5,422,821).

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Boies does not explicitly disclose that one of the data bases is the National Name and Address Data Base. However, Allen teaches the use of the National Name and Address Data Base (i.e., US PS National Change of Address database) to identify, intercept and forward incorrectly addressed mail pieces. Thus, it would have been within the level of ordinary skill in the art to further modify the method of Boies modified by Allum by adopting the teaching of Allen to identify, intercept and forward incorrectly addressed mail pieces.

(11) Response to Argument

A. In response to appellants' argument regarding the rejection of claims 1 and 6-21 under 35 U.S.C. § 103 (a) over Boies et al. (US PAT. 6,006,200) in view of Allum (US PAT. 5,420,403).

- *In response to Appellants' argument that "The cited references do not disclose or anticipate the steps of verifying in one or more data bases that recipient's name is listed with recipient's desired delivery address and placing recipient's desired delivery address on mail in codes form and human-readable form."*

- The Board's attention is directed to claim 1, lines 9-10 of Boies. More specifically, Boies clearly states the step of "accessing the master file database by a shipper to obtain the customer's shipping address." Of course, the step of "accessing the master file database" inherently includes "checking and **verifying** step", i.e., "to obtain the customer's shipping address", "the master file database" is accessed and the list of "the customer's shipping address" (*"the 'recipient's name with recipient's desired delivery address'"*) **must be checked and verified** prior to obtaining "the customer's shipping address" (*"placing recipient's desired*

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delivery address on mail”). In the instant case, the mere fact that Appellants employ the different expression than the cited reference would not impart the patentability to the appealed claims, since, for the reasons above, the step of “verifying in one or more data bases that recipient’s name is listed with recipient’s desired delivery address” is covered by Boies.

- The Board’s attention is further directed to column 1, lines 22-26 and 56-64 of Allum. More specifically, Allum states that “... the final sorting level which is a manual one based not on the postal code but the street and number address which forms the basis the delivery rout by the mail delivery person.” and one of the objects “is to provide further automation capability.” Of course, in view of Allum’s disclosure, it would have been within the level of ordinary skill in the art to modify the method of Boies by employing codes form and human-readable form address on mail to facilitate the routing of the mail automatically and to assist a delivery person to find correct delivery address at the final sorting level.

- *In response to Appellants’ argument that “the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion.” “the Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention.” and “In establishing the requisite motivation, it has been consistently held that both the suggestion and reasonable expectation of success must stem from the prior art, as a whole.”*

The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d

1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as started supra, Boies clearly states the claimed method except for the steps of placing recipient's desired delivery address on mail in coded form and human readable form and Allum clearly provides the suggestion and reasonable expectation of success, i.e., *by placing recipient's desired delivery address on mail in coded form and human readable form, the system will provide more efficient automatic sorting levels and final sorting level which is a manual one based not on the postal code but the street and number address which forms the basis of the delivery route by the mail delivery person*. Even if, there is no explicit teaching or suggestion of combining the cited references, it would have been common sense to place recipient's desired delivery address on mail in coded form and human readable form to perform *automatic sorting levels and final sorting level which is a manual one based not on the postal code but the street and number address which forms the basis of the delivery route by the mail delivery person* with minimum interruption.

B. In response to appellants' argument regarding the rejection of claims 6 and 7 under 35 U.S.C. § 103 (a) over Boies et al. (US PAT. 6,006,200) in view of Allum (US PAT. 5,420,403).

- *In response to Appellants' argument that "the post office only delivers mail addressed to a post office box to the recipient's post office box. The post office does not deliver mail addressed to a post office box recipient to the recipient's desired delivery address or allow the recipient to change its desired delivery address during specified period of time. The post office also does not determine recipient's desired delivery address from the virtual post office box identification and recipient's name; verify in one or more data bases that recipient's name is listed with recipient's desired delivery address and place recipient's desired delivery address on mail in coded and human readable form on the mail "*

The Board's attention is directed to the fact that the method and the system of Boies can be used any delivery vendors including U.S. Postal Service (see column 2, lines 4-10).

The Boards' attention is further directed to the fact that Boies in view of Allum discloses the claimed method as below.

Boies discloses a method of forwarding mail (i.e., a package delivered by U.S. Postal Service) that is addressed to a recipient (i.e., "a customer") and a virtual post office box (i.e., "a unique identifier to the customer") to be delivered directly to a recipient, said method comprises the steps of:

receiving recipient's name and information regarding recipient's desired delivery address (this step would have been inherent to create the database owned by the shipping company and to generate the unique identifier to the customer);

assigning a virtual post office box for individual recipients (see column 2, line 12, "to supply a unique identifier to the customer");

relating recipient's virtual post office box with recipient's desired delivery address (this step would have been inherent to be able to deliver the mail to the correct customer);

delivering to recipient's their assigned virtual post office box's identification (see column 2, line 12, "to supply a unique identifier to the customer");

placing virtual post office boxes on the mail (see column 2, lines 55-60);

reading mail to capture virtual post office box identification, when present (see column 2, lines 60-64);

determining recipient's desired delivery address from virtual post office box information and recipient's name (see column 2, lines 18-22 and 60-64);

verifying in one or more data bases that recipient's name is listed with recipient's desired delivery address (see claim 1, i.e., "accessing the master file database by a shipper to obtain the customer's shipping address."); and delivering the mail to the desired delivery address of the recipients (see column 2, lines 60-64).

Boies does not explicitly disclose the steps of placing recipient's desired delivery address on mail in coded form and human readable form. However, Allum discloses the use of coded form, human readable form or both to print a delivery label (see FIGS. 7 and 8) to facilitate the routing of the mail automatically and to assist a delivery person to find correct delivery addresses. Thus, it would have been obvious to one of ordinary skill in the art to modify the method of Boies by adopting the teachings of Allum to facilitate the routing of the package automatically and to assist a delivery person to find correct delivery addresses.

• *In response to Appellants' argument that "the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion." "the Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention." and "In establishing the requisite motivation, it has been consistently held that both the suggestion and reasonable expectation of success must stem from the prior art, as a whole."*

The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d

1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as started supra, Boies clearly states the claimed method except for the steps of placing recipient's desired delivery address on mail in coded form and human readable form and Allum clearly provides the suggestion and reasonable expectation of success, i.e., *by placing recipient's desired delivery address on mail in coded form and human readable form, the system will provide more efficient automatic sorting levels and final sorting level which is a manual one based not on the postal code but the street and number address which forms the basis of the delivery route by the mail delivery person*. Even if, there is no explicit teaching or suggestion of combining the cited references, it would have been common sense to place recipient's desired delivery address on mail in coded form and human readable form to perform *automatic sorting levels and final sorting level which is a manual one based not on the postal code but the street and number address which forms the basis of the delivery route by the mail delivery person* with minimum interruption.

C. In response to appellants' argument regarding the rejection of claims 8-10 under 35 U.S.C. § 103 (a) over Boies et al. (US PAT. 6,006,200) in view of Allum (US PAT. 5,420,403).

The statement for the rejection of claims 8-10 in the Final Rejection was merely a copy of the statement for the rejection of claims 8-10 in the Office Rejection mailed on June 19, 20001. Thus, appellants were given sufficient time of opportunity to seasonably challenge the correctness of the Examiner's assertion. A seasonable challenge constitutes a demand for evidence made as soon as practicable **during prosecution**. Thus, appellants are charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made. This is necessary because the examiner must be given the

opportunity to provide evidence in the next Office action or explain why no evidence is required. However, appellants chose not to seasonably traverse the well known statement **during examination** and the object of the well known statement was taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

D. In response to appellants' argument regarding the rejection of claims 12-13 under 35 U.S.C. § 103 (a) over Boies et al. (US PAT. 6,006,200) in view of Allum (US PAT. 5,420,403).

The statement for the rejection of claims 12 and 13 in the Final Rejection was merely a copy of the statement for the rejection of claims 12 and 13 in the Office Rejection mailed on June 19, 2000. Thus, appellants were given sufficient time of opportunity to seasonably challenge the correctness of the Examiner's assertion. A seasonable challenge constitutes a demand for evidence made as soon as practicable **during prosecution**. Thus, appellants are charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made. This is necessary because the examiner must be given the opportunity to provide evidence in the next Office action or explain why no evidence is required. However, appellants chose not to seasonably traverse the well known statement **during examination** and the object of the well known statement was taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

E. In response to appellants' argument regarding the rejection of claims 15-21 under 35 U.S.C. § 103 (a) over Boies et al. (US PAT. 6,006,200) in view of Allum (US PAT. 5,420,403).

The statement for the rejection of claim 15 in the Final Rejection was merely a copy of the statement for the rejection of claim 15 in the Office Rejection mailed on June 19, 2000. Thus, appellants were given sufficient time of opportunity to seasonably challenge the correctness of the Examiner's assertion. A seasonable challenge constitutes a demand for evidence made as soon as practicable **during prosecution**. Thus, appellants are charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made. This is necessary because the examiner must be given the opportunity to provide evidence in the next Office action or explain why no evidence is required. However, appellants chose not to seasonably traverse the well known statement **during examination** and the object of the well known statement was taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

F. In response to appellants' argument regarding the rejection of claim 22 under 35 U.S.C. § 103 (a) over Boies et al. (US PAT. 6,006,200) in view of Allum (US PAT. 5,420,403) and further in view of Allen et al. (US PA. 5,422,821).

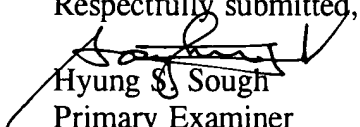
In response to appellants' argument against the Allen reference individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, as stated *supra*,

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Boies in view of Allum clearly discloses the steps of verifying in one or more data bases that recipient's name is listed with recipient's desired delivery address and placing recipient's desired delivery address on mail in codes form and human-readable form."

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,


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shs

May 30, 2002

Conferees

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1. The information disclosure statement filed April 8, 2002 fails to comply with 37 CFR 1.97(d) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered.